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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,104	11/10/1999	ASGEIR SAEBO	CONLINCO-040	8881

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MEDLEN & CARROLL, LLP  
101 HOWARD STREET  
SUITE 350  
SAN FRANCISCO, CA 94105

EXAMINER

JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/438,104

Applicant(s)

SAEBO ET AL.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 7-24 are pending.
2. Claims 7-24 are rejected.

### ***Withdrawal of Allowable Subject Matter***

3. In the Office Action of November 20, 2002, the only outstanding rejection was directed to the obviousness-type double patenting over the claims 1-16 of U.S. Patent No. 6,015,833. The corollary of this rejection indicated that the instant claims would be allowable if this rejection was overcome, such as through the filing of a proper terminal disclaimer.
4. However, the indicated allowability of claims 7-24 is now withdrawn in view of the newly discovered reference(s) to Pariza et al. of U.S. Patent No. 5,856,149 and Cain et al. of WO 97/18320. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cain et al. of WO 97/18320. Cain et al. teach of compositions of conjugated linoleic acid that are used in food products for both animals and humans, (see page 1). Cain et al. teach of a 91.8% conjugated linoleic acid product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer, (see Example 1). In addition, Cain et al. teach of alky esters of these conjugated linoleic acids (see Examples 1 and 3) as well as conjugated linoleic acid triglycerides, (see Example 8). Cain et al. also teach of utilizing the characterization method of HPLC as well as GC (see Example 8). Although Cain et al. do not specifically discuss peak area percentages of the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid, it would have been obvious to one having ordinary skill in the art that these isomers would be less than 1% of a peak area because Cain et al. teach of a conjugated linoleic acid composition product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer. Accordingly, Cain et al. teach of a composition which contains a total of 100 % of both the isomers of cis 9, trans 11-isomer and which would

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obviously exclude the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid. In addition, Cain et al. teach of utilizing the characterization method of HPLC as well as GC, which are known to present data results of analyzed products as percentages based on peak areas.

Accordingly, it would have been obvious to one having ordinary skill in the art to express the isomers of conjugated linoleic acid as peak area percentages especially when the prior art reference of Cain et al. teach of using the characterization techniques of HPLC and GC, (see the Examples of Cain et al.).

8. Claims 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariza et al. of U.S. Patent No. 5,856,149. Pariza et al. disclose that it is known in the art that conjugated linoleic acid is recognized as a nutritional supplement for mammals, (see column 1). Pariza et al. also disclose of a fatty acid composition, which contains more preferably between 98 and 99% of the cis-9, trans-11 isomers of 18 carbon fatty acids. Pariza et al. further disclose that the negligible remainder of the isomers produced are cis-9, cis-11 and trans-9, trans-11 isomers of conjugated linoleic acid, (see column 4, lines 24-35). In addition, Pariza et al. teach that these conjugated fatty acids may be free or bound chemically through ester linkages, (see column 4, lines 54-56). Since Pariza et al. teach of compositions, which contain up to 99% of cis-9, trans-11 isomers of conjugated linoleic acid and that "[t]he negligible remainder of the isomers produced are cis-9, cis-11 and trans-9, trans-11 configuration", it would have been obvious to the skilled artisan that this would result in a composition which contains well over 50% of conjugated linoleic acid, specifically 99%, and

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less than 1% of other negligible isomers of conjugated linoleic acid that would embrace all other isomers of 9,11- and 10,12 conjugated linoleic acid as well as other negligible isomers, such as 11,13-octadecadienoic and 8,10-octadecadienoic acid. It is further pointed out that Pariza et al. also teach of utilizing the characterization method of HPLC as well as GC, which are known to present data results of analyzed products as percentages based on peak areas. Accordingly, it would have been obvious to one having ordinary skill in the art to express the isomers of conjugated linoleic acid as peak area percentages especially when the prior art reference of Pariza et al. teach of using the characterization techniques of HPLC and GC, (see columns 7-10).

#### ***Obviousness-type Double Patenting***

9. The rejection of claims 7-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,015,833 is withdrawn in view of the properly filed Terminal Disclaimer of January 27, 2003.

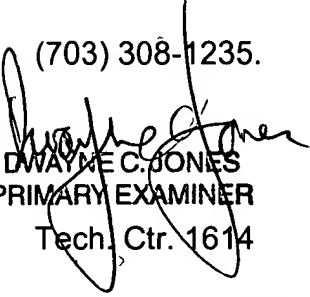
Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is

(703) 308-1235.

  
DWAYNE C. JONES  
PRIMARY EXAMINER  
Tech. Ctr. 1614

February 24, 2003